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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Richard Joseph Couture

Serial No. 74/734,547

Richard Joseph Couture, pro se.

Howard Smiga, Trademark Examining Attorney, Law Office 102 (Thomas V. Shaw, Managing Attorney).

Before Simms, Hairston and Chapman, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Richard Joseph Couture has filed an application to register the term GENERIC for "long distance telephone communication services; local telephone communication services; cellular telephone services."[1]

Registration has been refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the basis

[1] Application Ser. No. 74/734,547, filed September 26, 1995, alleging a bona fide intention to use the mark in commerce.

that, when used on applicant's services, the mark is merely descriptive of them.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm.

The Examining Attorney contends that the term GENERIC is merely descriptive of applicant's services in that the term is used in the communications industry to describe goods and services which are general in nature; and that the term "describes the applicant's services which feature general or generic telephone services." (Examining Attorney's brief, p. 2).

In support of the refusal, the Examining Attorney submitted numerous excerpted stories and one full story from a LEXIS/NEXIS search to demonstrate use of the word "generic" to describe various types of services, and in particular, telephone services.[2] The most pertinent and

[2] We must comment on the approximately 40 excerpts submitted by the Examining Attorney. Many of the excerpts were repetitive or were not pertinent as explained below. We caution that providing relevant excerpts is imperative. In this case, some of the excerpted stories indicate uses of the searched words (e.g., "generic services") in relation to Amtrak services, or car sales, or computer software, and thus, are of limited probative value in relation to telephone services; others are from wire services, and thus are of limited probative value in assessing the reaction of the public to the term applicant seeks to register because evidence from a proprietary news service is not presumed to have circulated among the general public; and some of the excerpted stories appeared in foreign publications (e.g., Canadian), and

convincing evidence from the excerpted stories includes the following:

> It is possible that in the future only a few companies will offer generic telephone service. There are bound to be niche players at the local level. And not all will survive. Remember how many companies were offering... "Telephone Engineer & Management," January 15, 1984.
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> ...30-second TV and 60-second radio spots from Tracy-Locke and running in six Western states have a generic long-distance push reminiscent of the days when Bell was the only logo in town. "Adweek," June 17, 1985;
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> ...multi-location conferencing, 800 services, and customized billing reports. Small-business owners these days want something more than generic telephone service, Burgess says.
> "They want to be treated like a big business," he says of small companies. "Very few people just want their... "The Business Journal-Portland," June 15, 1992;
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> ... pager and cellular telephone, said she's committed to competition in the wireless telecommunications industry.
> She said that while [the Department of] Justice supports a generic long-distance wireless waiver for Bell cellular firms, conditions like separate pricing must be included in the waiver because... "Crain Communications Radio Comm. Report," March 13, 1995; and
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> On the simplest level, promotional phone cards act as a minibillboard through which generic long distance is given to the customer as a gift with a purchase. This is frequently used merely to build greater awareness of both phone cards and the... "Supermarket News," April 15, 1996;

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are of limited probative value because it cannot be assumed that foreign uses had any material impact on the perceptions of the public in the United States. See In re Manco Inc., 24 USPQ2d 1938 (TTAB 1992); and In re Men's International Professional Tennis Council, 1 USPQ2d 1917 (TTAB 1986). In addition, a few of the excerpts were printouts of identical stories.

The full story submitted by the Examining Attorney is from "The Union Leader (Manchester, NH)" dated January 13, 1992, and carries the headline "Breaking Into NET'S Net: Phone Companies Jostling for Business Customers." This story includes the following statements: "Ten years after the federal government broke up the Bell System's monopoly over the nation's telephone service, it's being broken open at the state level," and "telephone service 'is pretty much a generic product. Quality and dependability are all pretty much the same, since you're almost literally on the same set of wires no matter who you're using. That brings it down to an issue of price and service.'"

The Examining Attorney has also made of record two dictionary definitions of "generic," one from Random House Unabridged Dictionary (Second Edition) which defines the term as "adj. 1. of, applicable to, referring to all members of a genus, class, group, or kind; general... 4. not protected by trademark registration: 'Cola' and 'shuttle' are generic terms," and the other from Webster's Ninth New Collegiate Dictionary which defines "generic" as "adj. 1. a: relating to or characteristic of a whole group or class: general b: being or having a nonproprietary name."

Applicant urges reversal of the refusal, arguing that following the breakup of the AT&T monopoly, there has been a proliferation of companies offering long distance, local and cellular telephone services; that each company offers its own unique service and there is not a "generic" telephone service; and that the term is arbitrary. In his brief on appeal applicant argues that the Office has allowed previous applications for marks which include the term GENERIC to publish and to register.[3] Finally, in applicant's reply brief, he argues that the Examining Attorney has not submitted sufficient evidence showing what meaning the term conveys to the relevant purchasing public.

A term is merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it immediately conveys information concerning an ingredient, quality,

[3] Attached to his brief is an exhibit which is a photocopy of a file of a third-party application to register the mark GENERIC TELEPHONE COMPANY. Also, within his brief applicant referred to two registrations for the term GENERIC and three registrations which included the term GENERIC as part of the mark. The Examining Attorney properly objected to this evidence as untimely. See Trademark Rule 2.142(d). Moreover, mere lists of registrations are not sufficient to make them of record. See In re Duofold Inc., 184 USPQ 638 (TTAB 1974). Applicant's exhibit attached to his brief, and applicant's list of five third-party registrations, will not be considered. We hasten to add, however, that even if we had considered this evidence, it would not change the result herein. (In fact, some of the third-party registrations issued under Section 2(f) of the Trademark Act, thus supporting the Examining Attorney's position that the term GENERIC is merely descriptive as to the involved goods or services.)

characteristic or feature thereof, or if it directly conveys information regarding the nature, function, purpose or use of the goods or services. See In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978). It is not necessary that a term or phrase describe all of the properties or functions of the goods or services in order for it to be considered merely descriptive thereof; rather, it is sufficient if the term or phrase describes a significant attribute or feature about them. Moreover, whether a term or phrase is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services, and the possible significance that the term or phrase would have to the average purchaser of the goods or services because of the manner of its use. See In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979). See also, In re Omaha National Corporation, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); In re Consolidated Cigar Co., 35 USPQ2d 1290 (TTAB 1995); and In re Pennzoil Products Co., 20 USPQ2d 1753 (TTAB 1991).

The Examining Attorney submitted two dictionary definitions of the term “generic,” and we take judicial

notice[4] of the following two additional dictionary definitions: (1) Webster's Third New International Dictionary which includes as a definition of "generic" "adj. ...b: available for common use: not protected by trademark registration: nonproprietary...used esp. in trademark law"; and (2) Webster's II New Riverside University Dictionary which includes as a definition of "generic" "adj. 1. pertaining to or describing an entire group or class: general ...3. not bearing a trademark or trade name." This evidence clearly shows a meaning of the term in the sense of general or common. The average prospective purchaser would perceive the term "generic" in the context of its commonly understood English meaning. That is, the purchasing public would immediately understand, without thought or imagination, that applicant's telephone services are generic, or general and common in nature. In addition, the Examining Attorney has put into the record some limited evidence of the descriptiveness of the term GENERIC in relation to telephone services, including the references quoted above, showing that since the breakup of AT&T, there have been

[4] See University of Notre Dame du Lac v. J. C. Gourmet Food Imports, 213 USPQ 594 (TTAB 1982), aff'd 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

numerous companies entering the telephone services market, and that there are generic or basic telephone services.

We acknowledge that when carefully reviewed the LEXIS/NEXIS evidence submitted by the Examining Attorney does not present an overwhelming showing of public perception of the term GENERIC in the context of long distance, local, and cellular telephone services. However, the Examining Attorney submitted sufficient overall evidence to present a prima facie showing that applicant's mark is merely descriptive of his services.

The Court of Appeals for the Federal Circuit has long recognized that "the practicalities of the limited resources available to the PTO are routinely taken into account in reviewing its administrative action." In re Loew's Theatres, Inc., 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985). Once the Office has met its burden of establishing a prima facie case, applicant must do more than merely argue the issue. The Court of Appeals for the Federal Circuit stated in the case of In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987) as follows:

> Appellant argues that descriptiveness is to be determined by the 'ultimate purchasers and not by those who would have seen the wholesale catalogue,' and that 'there is no evidence at all from the purchasing public.' It is correct that the trademark attribute of descriptiveness vel

> non is determined from the viewpoint of the purchaser. In re Bed & Breakfast Registry, 791 F.2d 157, 160, 229 USPQ 818, 819 (Fed. Cir. 1986). However, the burden of coming forward with evidence in support of the applicant's argument was upon the applicant. It is insufficient, in view of the PTO's prima facie case, to criticize the absence of additional evidence weighing against the applicant. Rebuttal evidence and argument are the applicant's province.

In this case, applicant's application is based on intent to use and, thus, there are no specimens of record for our review. Moreover, applicant submitted no timely admissible evidence prior to appeal relating to either his own intended use of his applied-for mark or third-party applications and registrations.

Accordingly, based on the record before us, we find applicant's applied-for mark GENERIC, as applied to applicant's long distance, local and cellular telephone services, immediately conveys to consumers that the services are general telephone services.

Decision: The refusal to register under Section 2(e)(1) is affirmed.

R. L. Simms

P. T. Hairston

B. A. Chapman
Administrative Trademark
Judges, Trademark Trial and
Appeal Board